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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,111	03/02/2004	Hirofaka Tanaka	Q80222	1148
23373 7590 07/07/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
WILSON, LEE D				
ART UNIT		PAPER NUMBER		
3723				
MAIL DATE		DELIVERY MODE		
07/07/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/790,111

**Applicant(s)**

TANAKA ET AL.

**Examiner**

LEE D. WILSON

**Art Unit**

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-4, 6-9, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Saito et al (6782717).

Saito et al teach a method comprising the steps of polishing glass substrate (18), a treating liquid (col.4, lines 1-4 (colloidal particles) and col.11, lines 29-31 (shows a liquid being pure water), a tape (23), disturbance of the texture is reduce (note the pure water for cleaning the glass substrate reads on this limitation), a magnetic layer (col.7, lines 28-30), aluminosilicate (col.3, lines 6-10), and a texture being formed along a circumference direction of the magnetic disk (abstract).

In regard to claims 8-9, see in particular claim 8 and then look at entire patent.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al (6782717) in view of Shimada (6632547).

- a. Saito et al are discussed above.
- b. Saito et al teach the claimed method steps except for chemical strengthened glass substrates.
- c. Shimada teaches a method comprising the steps of polishing glass substrate (col.1, 53-55 and fig.2a), a treating liquid (col.3, line 55 and col.5, 47-55 which shows a liquid having colloidal particles), a tape (col.5, 47-53), and a chemical strengthening (col.4, 45-65 and throughout the patent there are numerous other mentions.) which also for strengthening of a glass substrate.
- d. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Saito et al device by providing the chemical strengthened glass substrates step as taught by Shimada which also for strengthening of a glass substrate.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al (6782717) in view of Saito et al (2003/0110803A1).

- e. Saito et al are discussed above.
- f. Saito et al teach the claimed method steps except for chemical strengthened glass substrates.

- g. Saito et al (2003/0110803A1) teach a method comprising the steps of polishing glass substrate (abstract), a treating liquid (40 and a liquid having colloidal particles), a treating liquid (pure water par.98), a tape (30), and a chemical strengthening (abstract and throughout the patent there are numerous other mentions.) which also for strengthening of a glass substrate.
- h. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Saito et al device by providing the chemical strengthened glass substrates step as taught by Saito et al (2003/0110803A1) which also for strengthening of a glass substrate.

***Response to Arguments***

- 6. **Applicant's arguments filed in RCE on 4/25/08 have been fully considered but they are not persuasive.**
- 7. **Applicant feels that the prior art does not read on the instant invention in view of the amendment.**
- 8. **Applicant has amended the claims.**
  - i. The limitation is found in the prior art.
- 9. **Applicant states that Saito does not have post texturing irrigation.**
  - j. The amended limitation is found in the rejection of record in Saito (col.11, lines 24-31 and all of Example 1) and (col.13, lines 1-15 and comparative Example 2.).

k. The applicant does not claim Post texturing irrigation. These terms are not found in the claims so the point is moot.

**10. Applicant states Saito tape is not for cleaning.**

l. The tape is pressed against the glass while an performing an acid treatment which is part of cleaning. (summary of invention.)

m. The applicant states that cleaning can be with same tape used to abrade and the claims states cleaning occurs then the tape if reapplied. The prior art function is the same way especially if a piece had to be refined.

**11. Applicant states Saito does not teach stated range.**

n. Saito does teach  $R_p$  and  $R_{max}$  vaules because these speak the depth of the polished surface. If it discloses an average roughness then that means there is an inherentent depth from an  $R_p$  to a  $R_{max}$ .

**12. Applicant states 103 are invalid.**

o. The 103 are valid and arguments are addressed above. Therefore all rejections stand.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE D. WILSON whose telephone number is 571-272-4499. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH HAIL can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ldw

/LEE D WILSON/  
Primary Examiner, Art Unit 3723

JULY 3, 2008